REMARKS/ARGUMENTS

Claims 1-28 remain pending herein. Claims 2-5, 10-16 and 20-24 have been withdrawn from consideration.

The Office Action summary page indicates that certified copies of the priority documents have not been received from the International Bureau.

During a telephone conference with Mr. Benny Lee of the U.S. Patent and Trademark Office (Art Unit 2817) on January 9, 2004, Mr. Lee indicated that because the present application descended from a PCT application, there is no burden on the Applicant to provide copies of the priority documents to the U.S. Patent and Trademark Office (U.S. PTO), and that the U.S. PTO would obtain copies of the priority documents from the International Bureau. Accordingly, it is respectfully requested that the next Office Action contain an indication that copies of the certified copies of the priority documents have been received in the present application, or an explanation as to why the U.S. PTO has not obtained the copies of the certified copies of the priority documents which the International Bureau is required to provide to the U.S. PTO. Attached is a copy of form PCT/IB/304 which the Applicant received during the International Stage, confirming that the certified copies of the priority documents were received by the International Bureau.

Claims 1, 6-9, 17-19 and 25-28 were rejected under 35 U.S.C.§112, first paragraph.

The December 4, 2003 Office Action contains a statement that ". . . the specification, while being enabling for compounds given by chemical formulas I-VI on page 17-19 of the specification as the compound having an organic base and an inorganic acid and are unitarily combined in a molecule, does not reasonably provide enablement for all compounds having an organic base and an inorganic acid which are unitarily combined in a molecule" (December 4, 2003 Office Action, page 4, lines 5-9 from last). The Office Action, however,

gives no reasons why it deems that a person of skill in the art would not be able to make and use the present invention without having to engage in an undue amount of experimentation.

The specification contains statements that all of the subject matter encompassed by the present claims would be operative to produce a useful battery. The only relevant concern of the U.S. Patent and Trademark Office (U.S. PTO) should be over the truth of such statements that the invention would be operative as disclosed in the specification. A rejection for lack of enablement can only be made if there is reason to doubt the objective truth of the statements that the invention would be useful as disclosed in the specification. Whenever a rejection on this basis is made, it is incumbent upon the U.S. PTO to explain *why* it doubts the truth or accuracy of a statement in a supporting disclosure, and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. *In re Marzocchi & Horton*, 169 USPQ 367, 369 (CCPA 1971).

In any rejection under the enablement requirement of the first paragraph of 35 USC §112, the initial burden is on the U.S. PTO to establish that it would require undue experimentation for one of skill in the art to be able to make the claimed invention and to use the claimed invention. The December 4, 2003 Office Action fails to set forth any reasons to support the allegations by the USPTO that one of skill in the art would be unable to make and use the claimed invention without having to engage in an undue amount of experimentation. The U.S. PTO must substantiate rejections for lack of enablement with *reasons*. *In re Armbruster*, 185 USPQ 152, 153 (CCPA 1975). A specification which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in the claims must be accepted as satisfying the enablement requirement unless there is reason to doubt the objective truth of the statements in the specification. *In re Armbruster*, 185 USPQ 152 at 153.

In the present situation, the applicants has identified certain specific materials. The U.S. PTO has not given *any* reason to doubt the assertion by the present applicants that the other materials encompassed by the claims would behave similarly or at least sufficiently similarly that they are useful in making batteries.

The December 4, 2003 Office Action also includes a statement that:

> [t]here are innumerable compounds that are organic bases and innumerable compounds or elements that are inorganic acids and the specification does not provide sufficient guidance to one of ordinary skill in the art as to which organic base and inorganic acid reaction product is encompassed by the claims there are an infinite number of possible combinations. It would be undue experimentation to one of ordinary skill in the art to determine what compound having an organic base and an inorganic acid which are unitarily combined in a molecule is encompassed by the claim from at least thousands, if not millions of possibilities.

(December 4, 2003 Office Action, paragraph bridging pages 4 and 5).

The enablement requirement of 35 U.S.C. 112 does not require that an applicant discover which members within a generic group of materials function properly in accordance with the invention. As noted in *In re Grimme*, 124 USPQ 499, 501, "[i]t is manifestly impracticable for an applicant who discloses a generic invention to give an example of every species falling within it, or even to name every such species.

An analogous situation was presented in *In re Fuetterer*, 138 USPQ 217, 223 (CCPA 1963), in which the USPTO objected to the breadth of certain claims, stating that there would be an undue burden placed upon the public to determine what salts are suitable for obtaining the desired results (the claim recited "an inorganic salt that is capable of . . ."). The CCPA held that there is no requirement that an applicant discover which of all the salts within the generic expression in the claim would function properly in the invention. The court stated that the applicant's claims should not be limited to the salts enumerated in the specification so that they could be avoided merely by using some inorganic salt not named by the applicant in its disclosure. The court stated "the only undue burden which is apparent to us in the instant case is that which the Patent Office has attempted to place on the appellant - the Patent Office would require him to do research on the literally thousands of inorganic salts and determine

which of these are suitable for incorporation into his claimed combination." *In re Fuetterer*, 138 USPQ at 223.

Since the December 4, 2003 Office Action does not address factors which would give rise to a rejection under 35 U.S.C.§112, it is respectfully requested that the U.S. PTO reconsider and withdraw this rejection.

In view of the above, claims 1-28 are in condition for allowance.

If the Examiner believes that contact with Applicants' attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call Applicants' attorney at the phone number noted below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-1446.

Respectfully submitted,

March 4, 2004
Date

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PATENT COOPERATION TREATY

From the INTERNATIONAL BUREAU

PCT

NOTIFICATION CONCERNING SUBMISSION OR TRANSMITTAL OF PRIORITY DOCUMENT

(PCT Administrative Instructions, Section 411)

To:

WATANABE, Kazuhira
3rd Fl. No.8 Kikuboshi Tower Building
20-18, Asakusabachi 3-chome
Taito-ku, Tokyo 111-0053
JAPON

Date of mailing (day/month/year) 21 March 2001 (21.03.01)	
Applicant's or agent's file reference WA-0582	**IMPORTANT NOTIFICATION**
International application No. PCT/JP01/01135	International filing date (day/month/year) 16 February 2001 (16.02.01)
International publication date (day/month/year) Not yet published	Priority date (day/month/year) 28 March 2000 (28.03.00)
Applicant NGK INSULATORS, LTD. et al	

1. The applicant is hereby notified of the date of receipt (except where the letters "NR" appear in the right-hand column) by the International Bureau of the priority document(s) relating to the earlier application(s) indicated below. Unless otherwise indicated by an asterisk appearing next to a date of receipt, or by the letters "NR", in the right-hand column, the priority document concerned was submitted or transmitted to the International Bureau in compliance with Rule 17.1(a) or (b).

2. This updates and replaces any previously issued notification concerning submission or transmittal of priority documents.

3. An **asterisk(*)** appearing next to a date of receipt, in the right-hand column, denotes a priority document submitted or transmitted to the International Bureau but not in compliance with Rule 17.1(a) or (b). In such a case, **the attention of the applicant is directed** to Rule 17.1(c) which provides that no designated Office may disregard the priority claim concerned before giving the applicant an opportunity, upon entry into the national phase, to furnish the priority document within a time limit which is reasonable under the circumstances.

4. The **letters "NR"** appearing in the right-hand column denote a priority document which was not received by the International Bureau or which the applicant did not request the receiving Office to prepare and transmit to the International Bureau, as provided by Rule 17.1(a) or (b), respectively. In such a case, **the attention of the applicant is directed** to Rule 17.1(c) which provides that no designated Office may disregard the priority claim concerned before giving the applicant an opportunity, upon entry into the national phase, to furnish the priority document within a time limit which is reasonable under the circumstances.

Priority date	Priority application No.	Country or regional Office or PCT receiving Office	Date of receipt of priority document
28 Marc 2000 (28.03.00)	2000/89934	JP	02 Marc 2001 (02.03.01)
28 Marc 2000 (28.03.00)	2000/89936	JP	02 Marc 2001 (02.03.01)
28 Marc 2000 (28.03.00)	2000/89965	JP	02 Marc 2001 (02.03.01)
28 Marc 2000 (28.03.00)	2000/89972	JP	02 Marc 2001 (02.03.01)
28 Marc 2000 (28.03.00)	2000/89974	JP	02 Marc 2001 (02.03.01)

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